

Attorney Docket No. 30014200-1069

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

Igor Davidovich Kushnirskiy

Application No.: 10/023,008

Filed: December 12, 2001

For: Scriptable Plug-in

Application Programming Interface

Group Art Unit: 2194

Examiner: Truong, LeChi

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Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program introduced in the Official Gazette (July 12, 2005), Applicants respectfully request a pre-appeal brief review. Applicants request a review of the final rejection in the above-identified application. No amendments are being filed with this request. A Notice of Appeal is submitted herewith.

**I. STATUS OF CLAIMS**

Claims 1-3, 5-15, 17-27, and 29-37 are pending in the above-identified application.

Claims 1-3, 5-15, 17-27, and 29-37 were rejected in the Final Office Action dated June 13, 2005.

**II. STATUS OF AMENDMENTS**

An Amendment After Final was filed on September 13, 2005, wherein the claim rejections were traversed and independent claim 37 was added. An Advisory Action was mailed October 18, 2005, stating that the Amendment After Final had been entered but did not place the application in condition for allowance.

**III. ISSUES**

The issues to be reviewed are whether claims 1-3, 5, 9, 10, 13-15, 17, 21-27, 29, and 33-36 are properly rejected under 35 U.S.C. § 103(a) as unpatentable over *Lewallen* (U.S. Patent No. 6,854,123) in view of alleged Admitted Prior Art (APA), whether claims 6-8, 18-20, and 30-32 are properly rejected under 35 U.S.C. § 103(a) as unpatentable over *Lewallen* in view of *XPCOM*, and whether claims 12-14 are properly rejected under 35 U.S.C. § 103(a) as being unpatentable over *Narin et al.* (U.S. Patent No. 6,691,176, hereinafter "*Narin*") in view of the alleged APA.

**IV. ARGUMENT**

Applicant contends that there is no motivation to combine the cited art in such a way that renders the present claims unpatentable, and that the Examiner has used impermissible hindsight in asserting a motivation to combine. Applicant further contends that the cited art, alone or in combination, fails to teach or suggest every limitation of every claim. Applicant also submits that the alleged APA is not, in fact, admitted prior art, and that the Examiner has repeatedly

failed to respond to Applicant's traversals. Thus, the Examiner has omitted one or more essential elements needed for a *prima facie* rejection, and the rejections should be withdrawn.

A. There Is No Motivation To Combine the Cited References

Applicant respectfully submits that there is no motivation to combine the cited art. For example, as explained on page 12 of the Amendment After Final, there is no basis for a motivation to combine the references as proposed by the Examiner because there is no expectation that the proposed modification of *Lewallen* with the alleged APA could work. Furthermore, Applicant respectfully submits that the Examiner has used impermissible hindsight in constructing a motivation to combine the alleged APA and *Lewallen*. Arguments substantiating this assertion may be found on pages 12-13 of the Amendment After Final.

B. The Combined References Fail To Teach Every Limitation of Every Claim

*Lewallen*, alone or in combination with other cited references, fails to teach or suggest all of the limitations of every claim. For example, *Lewallen* fails to teach or suggest a scriptable plug-in "able to perform an inter-thread call through [a] proxy support interface" as recited in claim 23. The Examiner asserts that this limitation is taught by *Lewallen* at column 8, lines 34-39, which states:

In this way, the proxy object exposes the Java object and corresponding W3C API interface to one or more UI interfaces and objects. When processing calls to such a Java object, the bridge 4 would transform the call to the Java object to the multiple UI API interfaces specified in the proxy object to which the node info for the Java object points.

Notably, this portion of *Lewallen* says nothing of an "inter-thread call" as recited in claim 23. Moreover, *Lewallen* suggests that the call is made to a Java object. In fact, a scriptable plug-in would not need a proxy interface to call a Java object as it could call Java methods directly.

Thus, Applicant respectfully submits that *Lewallen* teaches neither a scriptable plug-in making a call through a proxy interface, nor an inter-thread call. Claims 11 and 35 recite similar limitations, and are thus allowable for at least the same reasons given for claim 23.

Regarding claims 11 and 12, the combination of *Narin* and the alleged APA fails to teach or suggest every limitation of those claims. *Narin* fails to teach or suggest, for example, that a service manager and interface proxy allows a scriptable plug-in to perform an inter-thread call to another scriptable plug-in or to a non-scriptable plug-in as taught and claimed by the Applicant. Detailed arguments against the rejection of claims 11 and 12 may be found in the Amendment After Final, pages 14-15.

C. The Examiner's Arguments Are Non-Responsive

In Applicant's Amendment of February 22, 2005, Applicant respectfully traversed the Examiner's assertion of "Admitted Prior Art." Applicant never admitted that the cited portions of the specification were "prior art" as defined by law (See MPEP 2129 and 35 U.S.C. § 102). In the Final Office Action, the Examiner again asserted that the cited portions of the specification are "prior art," and repeated this assertion without addressing Applicant's traversal. "Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's arguments and answer the substance of it." MPEP § 707.07(f). Applicant respectfully submitted that, for clarity of the record, the Examiner was required to address Applicant's traversal or else find new grounds for the rejection. In the Advisory Action, Applicant's traversal again went unanswered. Applicant respectfully submits that the Examiner's reliance on the alleged APA is erroneous.

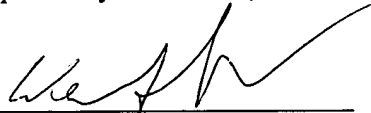
Furthermore, the Final Office Action stated that Applicant's arguments filed February 22, 2005, were moot in view of the new grounds of rejection. However, claims 11 and 12 were not rejected on new grounds. The rejection of claims 11 and 12, in view of the combination of *Narin* and the alleged APA, is identical to the rejection of those claims made in the non-Final Office Action mailed October 19, 2004. Accordingly, the Examiner repeated a rejection without answering Applicant's traversal of that rejection, in contravention of USPTO procedure, and the finality of the rejection is improper. *See* MPEP § 707.07(f).

#### IV. CONCLUSION

As explained the above remarks, there exists no motivation to combine *Lewallen* and the alleged APA. Even if motivation existed, which Applicant does not concede, the proposed combination would not teach or suggest every limitation of every claim. Furthermore, applicants do not concede that the alleged APA is prior art. Accordingly, Applicant submits that all claims are allowable over the cited prior art and respectfully request early and favorable notification to that effect.

Dated: November 14, 2005

Respectfully submitted,



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